



**10/689,970**

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellants:	Benjamin David Foster et al.	Examiner:	Adam Levine
Serial No.:	10/689,970	Group Art Unit:	3625
Filed:	October 20, 2003	Docket:	2043.090US1
Title:	LISTING RECOMMENDATION IN A NETWORK-BASED COMMERCE SYSTEM		

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In response to the Final Office Action mailed January 25, 2007, the Appellants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below:

**C.1 The Rejection of claims 1, 10, 21, 25, and 28 under § 112**

Appellants respectfully submits that claims 1, 10, 21, 25, and 28 conform to the requirements of § 112, second paragraph. The Final Office Action asserted that “the invention is different from what is defined in the claim(s) because claims 1, 10, 21, 25, and 28 do not include any distinct reference to a new, unique, or at least different search query created based on identified terms occurring within an original, first search query.” Final Office Action at p. 8, § 1.

Appellants respectfully submit that a close reading of the claims do in fact support Appellants’ previous argument. As a representative example, claim 1 recites “identifying a term associated with a user interaction ... the identified term occurring with a search query” and then further recites “automatically generating a recommendation query including the identified term.” These clauses found in claim 1, and similarly found in claims 10, 21, 25, and 28, specifically support a reference to a “new, unique, or at least different search query” (Appellants’ recommendation query) “based on identified terms occurring within an original, first search query” (Appellants’ search query). Accordingly, Appellants respectfully request reversal of this rejection of these claims.

**C.2 The Rejection of claim 12 under § 112**

Appellants respectfully submit that claim 12, as currently recited, conforms to the requirements of § 112, second paragraph. Appellants respectfully submit that the claim language as currently recited is to be broadly construed and encompass at least the variations described by the Final Office Action. Accordingly, Appellants respectfully request reversal of this rejection of this claim.

**C.3 The Rejection of claims 1,2, 4-11, 21, and 23-30 under § 102(b) using Hirooka**

Appellants respectfully submit that a *prima facie* case of anticipation of claims 1, 2, 4-11, 21 and 23-30 has not been established because Hirooka fails to disclose all elements as arranged of the present claims, as arranged in the claims.

**Concerning Claims 1, 21, 25, and 28**

In particular, Appellants cannot find in the cited portions of Hirooka “identifying a term associated with a user interaction in the network-based commerce system, the identified term occurring within a search query,” as currently recited in claim 1, and similarly recited in claims 21, 25, and 28. As discussed in a previous Office Action response, there is no reference to using a search query to determine a recommendation listing. Appellants respectfully submit that the only cited portion of Hirooka that does mention a search query concept is at § 3.3.1 in Hirooka, which states “it is easy to imagine that [a customer] uses different keywords to search in different book categories.” Apparently, Hirooka uses the statement to define a problem and proposes a solution of generating “generat[ing] several sets of keywords for each category that the customer has interest,” as stated in the following sentence. The mere mention of a search query concept does not provide an enabling disclosure as required to support a rejection under § 102. *See* M.P.E.P. § 2121.01 (citing *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003)). Hirooka then goes on to describe an implementation that does not actually use a search query, but rather builds a recommendation listing using one of three sources: book information, customer profile information, and customer purchases. *See* Hirooka at § 4.1. However, Hirooka does not disclose or describe identifying a term occurring within a search query, generating a recommendation query that includes the

search term, and presenting a recommended listing (identified using the recommendation query) to a user, as is required by claim 1 of the present application. The above argument is also applicable to a consideration of independent claims 21, 25, and 28. Thus, because Hirooka does not disclose or describe all elements of claims 1, 21, 25, and 28, Appellants respectfully submit that there is no *prima facie* case of anticipation and respectfully request withdrawal of the basis of these rejections of these claims.

#### Concerning Claim 6

Appellants cannot find in the cited portions of Hirooka “the identified term is selected based on its existence in a predetermined minimum number of user-generated search queries submitted to the network-based commerce system” as currently recited in claim 6. As discussed above with reference to claim 1, Hirooka apparently does not obtain terms from prior user queries (search queries) when constructing the vector of keywords for the customer’s profile. Moreover, Hirooka apparently does not disclose or describe the use of a “predetermined minimum number” of such queries. The Final Office Action takes the position that the predetermined minimum number could be one. Final Office Action, p. 10, lines 17-18. While Appellants do not dispute that a predetermined minimum number could be one, Appellants contend that regardless of this, Hirooka plainly does not disclose or describe the use of a predetermined minimum number in any form. As such, Hirooka would clearly fail to disclose only using keywords that exist a threshold minimum number of times in such user queries. Appellants respectfully submit that there is no *prima facie* case of anticipation and respectfully request withdrawal of the basis of this rejection of this claim.

#### Concerning Claim 10

Appellants cannot find in the cited portions of Hirooka “retrieving at least one popular search term associated with the category data; and generating the recommended listing based on the popular search term” as recited in claim 10. The Final Office Action apparently attempts to construe an equivalence of Hirooka’s keyword weighting system and Appellants’ popular search term limitation. Appellants respectfully disagree with such a characterization of Hirooka.

Hirooka’s keyword weighting scheme, specifically term frequency times inverse

document frequency (TFIDF), weights keywords found in books a customer has purchased. Hirooka at § 3.3.2, ¶¶ 3-8. As described in Hirooka, given a keyword, the frequency of the keyword in a book may proportionately increase the recommendation rating of the book, such that a book that contains more instances of the keyword are ranked higher when compared to other books that contain fewer instances of the keyword. This weighting is not equivalent to determining frequently used search terms. An obvious difference is that Hirooka's keyword is derived from a previous purchase—not a search—and thus, could not be a “popular search term” as required by claim 10. Appellants respectfully submit that there is no *prima facie* case of anticipation and respectfully request withdrawal of the basis of this rejection of this claim.

Concerning Claims 2, 4, 5, 7-9, 11, 23, 24, 26, and 27:

Appellants respectfully submit that claims 2, 4, 5, 7-9, 11, 23, 24, 26, and 27 depend directly or indirectly on independent claims 1, 21, and 25, respectively. As such, these dependent claims incorporate all the limitations of their parent independent claims. Accordingly, Appellants submit that these dependent claims are patentable for at least the reasons set forth above.

C.4 The Rejection of claims 3, 12-20, and 22 under § 103(a) using Hirooka in view of Ryan

Appellants respectfully submit that claims 3, 12-20, and 22 depend directly or indirectly on independent claims 1 and 21, respectively. As such, these dependent claims incorporate all the limitations of their parent independent claims. Accordingly, Appellants submit that these dependent claims are patentable for at least the reasons set forth above. Thus, Appellants respectfully request withdrawal of any basis of rejection of claims 3, 12-20, and 22.

### CONCLUSION

The Appellants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 408-278-4042 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,


BENJAMIN DAVID FOSTER ET AL.

By their Representatives,

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By /

  
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 25 day of April, 2007.

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